REMARKS

The present application was filed on December 15, 2003 with claims 1-33. Claims 1, 10, 16, 29 and 31-33 are the independent claims.

In the outstanding Office Action, the Examiner rejects claims 1-33 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,091,765 (hereinafter "Pietzold") in view of U.S. Patent No. 5,898,922 (hereinafter "Reininghaus").

In this response, Applicants respectfully traverse the §103(a) rejections. Applicants respectfully request reconsideration of the present application in view of the remarks below.

With regard to the §103(a) rejections, Applicants initially note that a proper *prima facie* case of obviousness requires that the cited references when combined must "teach or suggest all the claim limitations," and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejection of claims 1-33 over Pietzold and Reininghaus, in that the Pietzold and Reininghaus references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 1 is directed to a method of preconditioning a computer-controllable device. The method comprises determining at least one anticipated context with which the device may be associated, and determining at least one mode of operation associated with the at least one anticipated context such that the at least one mode of operation may be effectuated before or at a time when the anticipated context is at least partially realized.

The Examiner in formulating the §103(a) rejection of claim 1 argues that each and every one of the above-noted limitations is met by the collective teachings of Pietzold and Reininghaus. Applicants respectfully disagree.

In characterizing the Pietzold reference as allegedly meeting certain limitations of claim 1, the Examiner primarily relies on col. 5, lines 26-67. However, the relied-upon portions of Pietzold fail to teach or suggest the limitations as alleged.

Applicants respectfully disagree that Pietzold discloses the concept of "anticipated context." This term applies to events or conditions that are expected in the future. For example, FIG. 2 of the present application contains an extensive, yet not exhaustive, collection of anticipated contexts 200 that can be considered.

In contrast, Pietzold discloses a configurable device that operates in "current" time. As column 5, lines 55-60, explains, the device in Pietzold responds to instructions provided by the user to configure its current operational mode. In particular, the configuration is specifically responsive to current or currently desired operational conditions. This user-initiated operation does not contain any element of anticipated or projected context.

The Pietzold reference, in col. 5, lines 6-20, states the following, with emphasis supplied:

> In response to instructions provided from the user input circuit 26, the configuration control system 18 (in response to instructions or commands stored in the configuration memory 14) connects selected ones of a plurality of configurable digital signal processors (CDSP) 20 and 22, and configures the digital IF subsystem 24 in a receiver or transmitter mode of operation with the radio frequency subsystem 12 to function in accordance with the signaling scheme selected by the user. Hence, the arrangement is such that a single piece of equipment can be, in response to instructions from the user, configured to operate with a radio frequency subsystem 12 as a substantially universal type of radio frequency communications system, controlled the configurations inputted directly or loaded into the configuration memory 14.

Furthermore, Pietzold refers exclusively to the radio subsystem of a single device (see claim 1 in column 45, lines 36-67). The entire disclosure of Pietzold discloses exclusively how input from a user effectuates the configuration of the radio subsystem in response to immediate needs or

conditions. Illustrative principles of the invention relate to the entire device, and even though used in illustrative embodiments, the device is not required to contain a configurable radio subsystem. Any one (or a combination of) computer-controlled part(s) of the device, in an illustrative embodiment of the invention, is allowed to have its operation effectuated based on anticipated context. That is, illustrative principles of the invention may be applicable not only to the SDR in a device, but to its communication subsystem in general, its input/output modality capabilities, display fonts, and so on.

Finally, Pietzold discloses of a device that reacts in response of instructions provided through the user input module 26 that is used "for selecting the transmitter and receiver modes of operations and for selecting the communications signaling system" of a "field configurable radio frequency communications system" (see Pietzold at claim 1, column 45, lines 36-37 and 53-56). Illustrative principles of the invention do not require input by the user to effectuate the configuration of the device in the field. Because in illustrative principles of the invention, the device is preconfigured based on anticipated context, the device can change its mode of operation without user intervention. Modes of operation can change automatically whenever the device senses the existence of at least one of the anticipated context, e.g., switch service plans between the same or different service providers based on time of day. The latter may not require change of radio modulation techniques because the service plans could operate by a provider or providers that use the same radio modulation technique, as Pietzold discloses at col. 1, lines 51-53.

In characterizing the Reininghaus reference as allegedly meeting the limitation of "preconditioning a computer-controllable device" of claim 1, the Examiner relies on col. 1, lines 6-20. However, the relied-upon portions of Reininghaus fail to teach or suggest the limitation as alleged.

The Reininghaus reference, in col. 1, lines 6-20, states the following, with emphasis supplied:

> In accordance with international standards, mobile radio systems are available having open interfaces which allow a combination of functional devices--exchanges, data banks, radio devices, etc--from different manufacturers. Outgoing and incoming telephone calls can

be made everywhere in the mobile radio system, using one and the same mobile station, by means of a standard air interface for the wire-free link from the mobile stations of mobile subscribers to base station systems. A precondition for such a mobile radio system is a system of signaling links which is compatible throughout, in order to make it possible to transmit control information and data--as the generic term for all telecommunications signals which can be transmitted in the mobile radio system, such as voice signals, data signals etc--between the functional devices of the system.

The relied upon portion of Reininghaus does not disclose "a method of preconditioning a computer-controllable device," wherein the term "precondition" generally means "*tr. v.* to condition, train, or accustom in advance" (see "precondition" at http://dictionary.reference.com).

In an illustrative embodiment of the invention, "precondition" refers to "configur[ing] [the computer-controllable device]'s SDR dynamically as its operational context changes during, for example, the course of a day. For example, illustrative principles of the invention consider the possibility in which the SDR-enabled device may be expected to be used in the same location for multiple purposes and it would thus be advantageous for the device to be preconditioned to allow its operation for such purposes" (see the present specification at p. 7, lines 4-27). Instead, the Reininghaus reference, by way of contrast, associates the term "precondition" with a prerequisite (noun), where the precondition is for the mobile radio system to meet the prerequisite of having a system of signaling links which is compatible throughout.

The Reininghaus reference fails to supplement the above-noted deficiencies of Pietzold as applied to claim 1. Accordingly, it is believed that the combined teachings of Reininghaus and Pietzold fail to meet the limitations of claim 1.

Also, the Examiner has failed to identify a cogent motivation for combining Pietzold and Reininghaus in the manner proposed. The Examiner provides the following statement of motivation beginning at page 3, last paragraph of the Office Action:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to improve Pietzold, III et al by modifying the reconfigurable radio system architecture with disclose preconditioning a computer-controllable device for the purpose of signaling links which is compatible throughout to transmit control information and data.

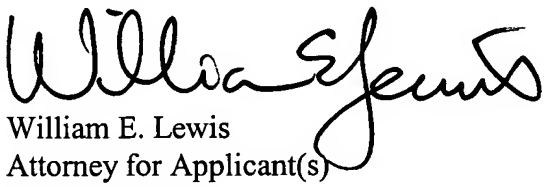
The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344. There has been no showing in the present §103(a) rejection of claim 1 of objective evidence of record that would motivate one skilled in the art to combine Pietzold and Reininghaus to produce the particular limitations in question. The above-quoted statement of motivation provided by the Examiner appears to be a conclusory statement of the type ruled insufficient in the In re Sang-Su Lee case. Accordingly, the proposed combination appears to be based primarily on hindsight, with the Examiner attempting to reconstruct the claimed arrangement from disparate references.

Based on the above, Applicants believe that claim 1 is allowable. Also, since independent claims 10, 16 and 31-33 recite the concept of "projected" or "anticipated" context, and claim 29 recites the concept of "a target of communication,"Applicants believe that such claims are also allowable.

Regarding the claims that depend from the various independent claims, Applicants assert that such claims are patentable not only due to their respective dependence on such claims, but also because such claims recite patentable subject matter in their own right.

In view of the above, Applicants believe that claims 1-33 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejection.

Respectfully submitted,



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